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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,920	12/12/2003	Michael Muller	IBM-001	2237
51835	7590	01/09/2008	EXAMINER	
IBM LOTUS & RATIONAL SW c/o GUERIN & RODRIGUEZ 5 MOUNT ROYAL AVENUE MOUNT ROYAL OFFICE PARK MARLBOROUGH, MA 01752			JOO, JOSHUA	
		ART UNIT	PAPER NUMBER	
		2154		
		MAIL DATE		DELIVERY MODE
		01/09/2008		PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/734,920	MULLER ET AL.
Examiner	Art Unit	
Joshua Joo	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 26 October 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-25 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 12/12/03 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

***Detailed Action***

1. This Office action is in response to communication dated 10/26/2007

Claims 1-25 are presented for examination.

**Response to Arguments**

2. Applicant's arguments filed 10/26/2007 have been fully considered but they are not persuasive.

(1) Applicant argued that 35 USC 101 rejection of claims 23-25 is moot because when functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases. In addition, "functional descriptive material" consists of computer programs which impart functionality when employed as a computer component.

3. In response, Examiner respectfully disagrees since claim 25 does not recite a feature of program code recorded on a computer-readable medium but of program code embodied on a computer-readable medium. The term "embodied" may be interpreted as "incorporated", and the instant specification does not provide a clear description of the term "computer useable medium". One of ordinary skill may reasonably interpret "computer useable medium having embodied there program code" as program code incorporated in a medium such as transmission medium. Furthermore, MPEP 2106.01 recites, "When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim." In this case, the program code is not recited in conjunction with a physical structure and does not fall under a product claim.

**Claim Rejections - 35 USC § 101**

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and

requirements of this title.

5. Claims 23-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
6. Regarding claim 23, Applicant is seeking to patent a computer program product for use with a computer system, the computer program product comprising a computer useable medium having embodied therein program code. The computer program product does not comprise any hardware structure and does not store data. The computer program product embodies program code, which may be interpreted as software or signal per se, i.e. signal or software embodying code. The claimed invention of the computer program product does not meet one of the four categories of invention and is not statutory.

#### **Claim Rejections - 35 USC § 102**

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2, 10-11, 18, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by

Request for Comments: 2822, P. Resnick, April 2001 (RFC 2822 hereinafter).

9. As per claim 1, RFC 2822 teaches the invention as claimed including a method of communicating with a user of a processor-based device over a network, the method comprising:

providing a body-less electronic mail message having a subject line and lacking a message body capable of receiving message content (Section 3.6; 3.6.5. Subject field. Section 2.1. Optional body. Since body is optional, a message does require a body and thus may lack a body.);  
receiving a text message into the subject line of the body-less electronic mail message (Section 3.6.5. Subject contains short string.); and

transmitting the body-less electronic mail message to the user over the network (Abstract; section

1.1. Text message between computer users.).

10. As per claim 10, RFC 2822 teaches the invention as claimed including a computing system comprising:

a display screen; an input device; a network interface (Abstract; section 1.1. Computer for transmitting message.); and

a processor running an electronic mail program to present to a user on the display screen (Section 1.1; 13.4; 3.6.1. Suggests of using mail application and messaging between computer users. Processor is inherent in a computer and essential to running an application.) a body-less electronic mail message having a subject line and lacking a message body capable of receiving message content (Section 3.6; 3.6.5. String in a subject field. Section 2.1. Optional body. Since body is optional, a message does require a body and thus may lack a body.), wherein the user operates the input device to enter a text message into the subject line of the body-less electronic mail message (Section 3.6.5. Subject contains short string.), and the network interface transmits the body-less electronic mail message having the text message in the subject line over a network (Abstract; section 1.1. Text message between computer users.).

11. As per claim 18, RFC 2822 teaches the invention as claimed including an apparatus for communicating with a user of a processor-based device over a network, the apparatus comprising:

means for providing a body-less electronic mail message having a header and lacking a message body capable of receiving message content (Section 3.6; 3.6.5. Subject field. Section 2.1. Optional body. Since body is optional, a message does require a body and thus may lack a body.);

means for recording a temporal sequence of one or more text messages into the header of the body-less electronic mail message (Section 3.6.5. Subject contains short string.); and means for transmitting the body-less electronic mail message to the user over the network (Abstract; section 1.1. Text message between computer users.).

12. As per claim 23, RFC 2822 teaches the invention as claimed including a computer program product for use with a computer system, the computer program product comprising a computer useable medium having embodied therein program code comprising:

means for providing a body-less electronic mail message having a header and lacking a message body capable of receiving message content (Section 3.6; 3.6.5. Subject field. Section 2.1. Optional body. Since body is optional, a message does require a body and thus may lack a body.);

means for recording a temporal sequence of one or more text messages into the header of the body-less electronic mail message (Section 3.6.5. Subject contains short string.); and

means for transmitting the body-less electronic mail message to the user over the network (Abstract; section 1.1. Text message between computer users.).

13. As per claims 2 and 11, RFC 2822 teaches the method of claim 1, wherein the subject line of the body-less electronic mail message includes one or more other text messages taken from a subject line of a previous body-less electronic mail message (Section 3.6.5. Subject field may start with "Re:" followed by subject of original message.).

14. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over RFC 2822, in view of Szeto et al. US Publication #2004/0215721 (Szeto hereinafter) and Rukman, US Publication #2004/0185883 (Rukman hereinafter).

15. As per claim 3, RFC 2822 does not specifically teach the method of claim 1, wherein the subject line of the body-less electronic message includes one or more other text messages taken from a chat conversation converted into a format of a body-less electronic mail message.

16. Szeto teaches a system for converting an instant message into an e-mail message (Paragraph 0036):

17. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of RFC 2822 and Szeto to convert an instant message into the email message such as the format of the message in RFC 2822. The motivation for the suggested modification is that Szeto's teachings would provide a predictable result of expanding a user's ability to communicate with other users, and in this case, allow instant messaging between an email user and instant messaging user (abstract; paragraph 0009).

18. RFC 2822 and Szeto still do not specifically teach that the subject line of the body-less electronic message includes one or more other text messages taken from the chat conversation.

19. Rukman teaches of converting a SMS message into a MMS message, which can be used to send an email, wherein the text of the SMS message is included in the subject line of the MMS message (Paragraph 0006; 0044).

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the suggested system of RFC 2822 and Szeto with the teachings of Rukman to convert a first message format into a second message format, wherein the text of the first message is included in the subject line of the second message. The motivation for the suggested combination is that Rukman's teachings would allow identification of the message in the subject header and still allow the recipient to check the content in the header in communication between different formats.

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21. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over RFC 2822, in view of Kalfas, US Publication #2004/0199598 (Kalfas hereinafter) and Whittle et al. US Publication #2005/0050462 (Whittle hereinafter).
22. As per claims 4 and 12, RFC 2822 does not specifically teach the method of claim 1, further comprising receiving the body-less electronic mail message over the network, displaying the body-less electronic mail message on a display screen as a line item in a mailbox view and displaying on the display screen an entire contents of the subject line when a cursor is positioned over a subject column of the line item.
23. Kalfas teaches a system for email notifications, wherein electronic mail message is received over a network and displayed on a display screen as a line item in a mailbox view (Paragraph 0037. List of email messages.).
24. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the body-less electronic mail messages as taught by RFC 2822 to be received and displayed as a line item in a mailbox view. The motivation for the suggested combination is that Kalfas's teachings would provide a user-friendly interface for viewing emails.
25. RFC 2822 and Kalfas do not specifically teach of displaying on the display screen an entire contents of the subject line when a cursor is positioned over a subject column of the line item.
26. Whittle teaches of positioning a pointer over a text to cause the entire partition of the text to be displayed (abstract; paragraph 0023).
27. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the suggested system of RFC 2822 and Kalfas with the teachings of Whittle to implement a system wherein positioning a pointer over a text, such as text of a subject line, causes the entire portion of the text to be displayed. The motivation for the suggested combination is that Whittle's teachings would

allow users to efficiently view content and optimize the use of space on a window (Paragraph 0020; 0022).

28. Claims 5, 13, 20, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over RFC 2822, in view of Kalfas and Lenoir, US Patent #7,231,082 (Lenoir hereinafter).

29. As per claims 5 and 13, RFC 2822 does not specifically teach the method of claim 1, further comprising receiving the body-less electronic mail message over the network, displaying the body-less electronic mail message on a display screen as a line item in a mailbox view having a column for the subject line, and displaying on the display screen a scroll bar arrow at one end of the subject line column, when a cursor is positioned over the subject column of the line item, for horizontally scrolling through the contents of the subject line.

30. Kalfas teaches a system for email notifications, wherein electronic mail messages are received over the network and displayed on a display screen as a line item in a mailbox view having a column for the subject line (Paragraph 0037. Display listing of email messages. Subject column.).

31. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the body-less electronic mail messages as taught by RFC 2822 to be displayed as a line item in a mailbox view having a column for the subject line. The motivation for the suggested combination is that Kalfas's teachings would provide a user-friendly interface for viewing emails.

32. RFC 2822 and Kalfas still do not specifically teach of displaying on the display screen a scroll bar arrow at one end of the subject line column, when a cursor is positioned over the subject column of the line item, for horizontally scrolling through the contents of the subject line.

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33. Lenoir teaches of horizontal scroll bar at the end of a column for scrolling through the contents of the column (col. 11, lines 25-30. Pointer/cursors are inherent, and the horizontal scroll bar is displayed when a cursor is positioned on the column.).

34. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the suggested system with the teachings of Lenoir to implement a horizontal scroll bar at the end of a column for scrolling through the contents of the column. The motivation for the suggested combination is that Lenoir's teachings would provide a predictable result of allowing a user to view the contents in a column, such as the subject, that is out of the viewing area.

35. As per claims 20 and 25, RFC 2822 does not specifically teach the apparatus of claim 18, further comprising means for displaying the body-less electronic message as a line item in a mailbox view and for horizontally scrolling through the sequence of one or more text messages while in the mailbox view.

36. Kalfas teaches a system for email notifications, wherein electronic messages are displayed as a line item in a mailbox view (Paragraph 0037. List of email messages.).

37. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the body-less electronic mail messages as taught by RFC 2822 to be displayed as a line item in a mailbox view. The motivation for the suggested combination is that Kalfas's teachings would provide a user-friendly interface for viewing emails.

38. RFC 2822 and Kalfas does not specifically teach of horizontally scrolling through the sequence of one or more text messages while in the mailbox view.

39. Lenoir teaches of horizontal scroll bar at the end of a column for scrolling through the contents of the column (col. 11, lines 25-30).

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40. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the suggested system with the teachings of Lenoir to implement a horizontal scroll bar at the end of a column for scrolling through the contents of the column. The motivation for the suggested combination is that Lenoir's teachings would provide the predictable results of allowing a user to view the contents in a column, such as the subject, that is out of the viewing area.

41. Claims 6, 19, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over RFC 2822, in view of Kalfas.

42. As per claim 6, RFC 2822 does not specifically teach the method of claim 1, further comprising inserting a delimiter into the subject line to separate the text message from a previous text message currently included in the subject line.

43. Kalfas teaches of a system for email notifications, wherein a user may input text into the subject line of an email message (Paragraph 0034. Complete message in a subject.).

44. Although Kalfas does not specifically teach of inserting the delimiter, Kalfas does teach that a user may insert text. Therefore, it would have been obvious to one of ordinary skill to in the art to combine the teachings and for a user to type a symbol such as “:”, “/”, other types of characters or symbols, which would allow a user to customize email messages and organize texts in a message including texts from a previous message.

45. As per claims 19 and 24, RFC 2822 does not specifically teach the apparatus of claim 18, further comprising means for displaying the body-less electronic mail message as a line item in a mailbox view and for displaying the entire temporal sequence of one or more text messages while in the mailbox view.

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46. Kalfas teaches of a system for email notifications, wherein electronic mail messages are displayed as a line item in a mailbox view and the entire temporal sequence of one or more text messages while in the mailbox view are displayed (Paragraphs 0037-0038. List of emails. Message is displayed in subject column. No need to open message.).

47. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the body-less electronic mail messages as taught by RFC 2822 to be displayed as a line item in a mailbox view, wherein the entire temporal sequence of one or more text messages while in the mailbox view are displayed. The motivation for the suggested combination is that Kalfas's teachings would provide a user-friendly interface for conveniently browsing and viewing emails.

48. Claims 7-9, 14-17, 21-22, are rejected under 35 U.S.C. 103(a) as being unpatentable over RFC 2822, in view of Szeto.

49. As per claims 7, 14, and 21, RFC 2822 does not specifically teach the method of claim 1, further comprising converting the body-less electronic mail message to an online electronic chat conversation.

50. Szeto teaches of a system for converting an e-mail message into instant message (Paragraphs 0041-0042).

51. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the body-less electronic mail message as taught by RFC 2822 to be converted into an instant message as taught by Szeto. The motivation for the suggested modification is that Szeto's teachings would provide a predictable result of expanding a user's ability to communicate with other users, and in this case, allow instant messaging between an email user and instant messaging user (abstract; paragraph 0009).

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52. As per claims 8, 15, and 22, RFC 2822 does not specifically teach the method of claim 1, further comprising converting a chat conversion into a body-less electronic mail message.

53. Szeto teaches of a system for converting an instant message into an e-mail message (Paragraph 0036).

54. It would have been obvious to one of ordinary skill in the art at the time the invention was made combine the teachings to convert an instant message into the email message as taught by Szeto such as a body-less electronic mail message as taught by RFC 2822. The motivation for the suggested modification is that Szeto's teachings would provide a predictable result of expanding a user's ability to communicate with other users, and in this case, allow instant messaging between an email user and instant messaging user (abstract; paragraph 0009).

55. As per claim 9, RFC 2822 taught of messaging using a body-less electronic mail message. RFC 2822 does not specifically teach the method of claim 1, further comprising displaying on a user interface a chat-like graphical window for engaging in synchronous chat in response to receiving the body-less electronic mail message over the network.

56. Szeto teaches of a system for engaging in instant messaging in response to receiving an email (Paragraphs 0036; 0043. User sends and receives message. Displaying a window is inherent to read and write messages. It is also inherent that instant messaging is done in real time.).

57. It would have been obvious to one of ordinary skill in the art at the time the invention was made combine the teachings of RFC 2822 and Szeto to engage in instant messaging in response to receiving an email. The motivation for the suggested modification is that Szeto's teachings would provide a predictable result of expanding a user's ability to communicate with other users, and in this case, allow instant messaging between an email user and instant messaging user (abstract; paragraph 0009).

58. As per claim 16, RFC 2822 does not specifically teach the computing system of claim 10, wherein the network interface communicates with the network over one of a wired and wireless connection.

59. Szeto teaches of a system for allowing an instant messaging user to communicate with an e-mail user, wherein a network connection may be over a wired and/or wireless media (Paragraph 0045).

60. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of RFC 2822 and Szeto to implement network connection over a wired and/or wireless media. The motivation for the suggested modification is that Szeto's teachings would enhance the capability of RFC 2822 by allowing communication over different types of media.

61. As per claim 17, RFC 2822 does not specifically teach the computing system of claim 10, wherein the computing system is one of a computer, a workstation, a personal digital assistance, a cellular telephone, and an online gaming platform.

62. Szeto teaches of the client device including a computer, pda, laptop, or a mobile phone (Paragraph 0045).

63. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of RFC 2822 and Szeto for a computing system to include a computer, pda, laptop, or a mobile phone. The motivation for the suggested modification is that Szeto's teachings would expand the usability of RFC 2822 by allowing the standard to be implemented and operated in different types of devices commonly owned by users.

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### Conclusion

64. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

65. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

66. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Friday 7 to 4.

67. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

68. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair>-

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NATHAN FLYNN  
SUPERVISORY PATENT EXAMINER

January 2, 2008

JJ